REMARKS

In response to the Final Office Action dated January 9, 2006 (the "Office Action"), Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the proposed combination of *Gurbani*, *Tannenbaum*, and/or *Bushnell*.

Claims 1-25, 27-53, and 55-62 are pending in this application.

The United States Patent and Trademark Office (the "Office") objected to numbering informalities of some of the claims, rejected claims 1-4, 11-22, 27-33, 36, 41-50, and 55-62 under 35 U.S.C. § 103 (a) as being unpatentable over *Gurbani et al.* (U.S. Patent No. 6,282,275), rejected claims 7, 9, 23, 25, 37, 39, 51, and 53 under 35 U.S.C. § 103 (a) as being unpatentable over *Gurbani* in view of *Tannenbaum et al.* (U.S. Patent No. 5,901,209), and rejected claims 5, 6, 8, 10, 24, 26, 34-35, 38, 40, 52, and 54 under 35 U.S.C. § 103 (a) as being unpatentable over *Gurbani* in view of *Bushnell* (U.S. Patent No. 2002/0067816).

As the Assignee shows, however, the pending claims are fully enabled and already distinguish over the proposed combination of *Gurbani*, *Tannenbaum*, and/or *Bushnell*.

Claim Objections

The Office objected to some of the claims for numbering dependent claims with reference to an incorrect independent claim number claim. In this Response, these claims have been renumbered to overcome the cited informalities. Therefore, the objections of

these claim are now moot, and Assignee respectfully requests that the Office remove these objections.

Rejection of Claims under § 103(a)

The Office rejected rejected claims 1-4, 11-22, 27-33, 36, 41-50, and 55-62 under 35 U.S.C. § 103 (a) as being unpatentable over *Gurbani et al.* (U.S. Patent No. 6,282,275), rejected claims 7, 9, 23, 25, 37, 39, 51, and 53 under 35 U.S.C. § 103 (a) as being unpatentable over *Gurbani* in view of *Tannenbaum et al.* (U.S. Patent No. 5,901,209), and rejected claims 5, 6, 8, 10, 24, 26, 34-35, 38, 40, 52, and 54 under 35 U.S.C. § 103 (a) as being unpatentable over *Gurbani* in view of *Bushnell* (U.S. Patent No. 2002/0067816). If the Office wishes to establish a *prima facia* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, the combination of *Gurbani, Tannenbaum,* and/or *Bushnell* does not teach, suggest, or otherwise suggest motivation to combine the references for the claimed subject matter. Further; the combination does not meet the burden of proof for a reasonable expectation of success nor does the combination have a reasonable expectation of success. Still further, the combination does not disclose, teach, and/or suggest all of the claimed subject matter. The Assignee, then, respectfully requests the Office to remove the § 103 rejections of claims 1-25, 27-53, and 55-62 and to allow these claims.

Independent claims 1, 18, 31, and 46 are reproduced below:

1.   A method for providing enhanced caller information to a subscriber using an advanced intelligent network, said method comprising:

receiving on a server *a plurality of user profile information from a user*, said user profile information comprising at least <u>*a caller directory number*</u> and <u>*at least one enhanced caller information that is pre-entered by the user*</u>;

provisioning a trigger on the subscriber's telephone line at a service switching point;

receiving a call from a caller to the subscriber at the service switching point, wherein said call encounters the trigger;

sending a query to a service control point in response to the trigger;

sending a message from the service control point to the server in response to the query, *said message comprising <u>a calling party number</u> and <u>a called party number</u>*;

matching, at the server, <u>the calling party number</u> to the <u>caller directory number</u>;

selecting, at the server, based on the <u>called party number</u>, an enhanced profile information from the user profile information that has <u>the caller directory number</u> matching with the <u>calling party number</u>; and

providing the enhanced caller information from the server to the subscriber, said enhanced caller information being based at least in part on the user profile information.

18.   A system for providing enhanced caller information using an advanced intelligent network, said system comprising:

a trigger provisioned on a subscriber's telephone line at a service switching point;

a service control point in communication with the service switching point; and

a server in communication with the service control point, said server being configured to receive a plurality of user profile information from a user, wherein said *user profile information comprises <u>at least a caller directory number</u> and <u>at least one enhanced caller information that is pre-entered by the user</u>*, and wherein when a call to the subscriber is received at the service switching point, a query is sent from the service switching point to the service control point, and wherein in response to the query, the service control point sends *a message to the server and the message comprises <u>a calling party number</u> and <u>a called party number</u>*, and wherein in response to a request by the subscriber, the server *selects an enhanced profile information based on <u>the calling party number</u> and the <u>called party number</u> and <u>provides the enhanced caller information to the subscriber, said enhanced caller information is based at least in part on the user profile information</u>*.

31.   A method for providing enhanced caller information using an advanced intelligent network, said method comprising:

receiving on a server a plurality of user profile information, said *user profile information comprises <u>at least a caller directory number</u> and <u>at least one enhanced caller information that is pre-entered by a user</u>*;

provisioning a trigger on a subscriber's telephone line at a mobile switching center;

receiving a call from a caller to the subscriber at the mobile switching center, wherein said call encounters the trigger;

sending a query to a service control point in response to the trigger;

sending a message from the service control point to the server in response to the query, *said message comprising a calling number and a called number*;

matching, at the server, the calling party number to the caller directory number;

selecting, at the server, based on the called number, <u>an enhanced caller information from the user profile information that has the caller directory number matching with the calling party number</u>; and

providing the enhanced caller information from the server to the subscriber, <u>said enhanced caller information being based at least in part on the user profile information</u>.

46.   A system for providing enhanced caller information using an advanced intelligent network, said system comprising:

a trigger provisioned on a subscriber's telephone line at a mobile switching center;

a service control point in communication with the mobile switching center; and

a server in communication with the service control point, said server being configured to receive a plurality of user profile information from a user, wherein *said user profile information comprises at least a caller directory number and at least one enhanced caller information that is pre-entered by the user*, and wherein when a call to the subscriber is received at the mobile switching center, a query is sent from the mobile switching center to the service control, and wherein in response to the query, the service control point sends a message to the server and *the message comprises a calling party number and a called party number*, and wherein in response to a request by the subscriber, *the server selects an enhanced caller information based on the calling party number and called party number and provides the enhanced caller information to the subscriber, said enhanced caller information is based at least in part on the user profile information*.

U.S. Patent Application No. 09/964,390, claims 1, 18, 31, and 46 (emphasis added by Assignee).

The Office erroneously asserts in the Final Office Action that:

1. *Gurbani* teaches a "user profile information that is pre-entered by the user (Fig. 2A and 2B and col. 3, lines 56-66 – where Gurbani discussed caller name, caller No., and time, hence caller information pre-entered by the user)." Office Action, p. 3.

2. *Gurbani* teaches "retrieving at the server calling party identification service profile and determining if the called party is a subscriber the[n] providing the caller information to the subscriber (col. 2, lines 53-58)." Id.

3. While *Gurbani* does not specifically teach matching the calling party number to the caller directory number, "it is necessary to match the calling party number to the caller directory number in the user profile information at the server in order to retrieve the correct caller information and provide the subscriber with accurate caller information." Id.

4. *Gurbani* teaches customer premise equipment includes cellular phones with data display (col. 2, lines 36-41), therefore, it would have been obvious that there exists a mobile switching center in order to provision the subscriber's cellular phone. Id., p. 4.

Gurbani does not teach, disclose, or otherwise suggest the claimed subject matter. Rather, *Gurbani* provides:

> Briefly stated, in accordance with one aspect of the invention the aforementioned problems are over come and a technical advance achieved by *providing a method of retrieving caller identification information about an incoming call from a calling station to a called station. The method includes the steps of receiving the incoming call at a local switch to which a line of the called station is connected, determining from the incoming call caller ID information, storing the caller ID information in a memory of a caller ID unit that is connected to the local switch and also to an internet network, accessing the caller ID unit via the internet network; and retrieving the caller ID information from the caller ID unit via the internet network.*
>
> *This caller ID information is subsequently displayed, usually, on a display of a browser or some other internet protocol communication device.* These displays usually have interactive areas so click to dial to call an entry on the caller ID display can be effected.

BRIEF DESCRIPTION OF THE DRAWING

FIG. 1 is a simplified diagram of a system arrangement for practicing storing and retrieving caller identification information.

FIGS. 2A and 2B are simplified diagrams of a chronological display of retrieved caller identification information and a prioritized display of retrieved caller identification information, respectively.

FIG. 3 is a flow diagram for logging a call.

FIG. 4 is a flow diagram for retrieving a call log over an IP network.

DETAILED DESCRIPTION

Referring now to FIG. 1, a system 100 is shown that is useful for practicing the method for storing and retrieving a caller identification according to the present invention. *A caller at telephone station 102*

initiates a call to called party at telephone station 104 by using public switched telephone network (PSTN) 110. Telephone station 102 maybe connected to PSTN 110 via a POTS service, an ISDN service, a wireless service or even a telephone over internet call service, as long as PSTN 110 can receive the initiated call. PSTN 110 may include a local telephone switch (not shown), such a 5ESS.RTM. by Lucent Technologies Inc. of Murray Hill, N.J. or comparable local telephone switch. *PSTN 110 upon receiving the call initiated from telephone station 102 forwards information of the call to signaling transfer point (STP) 114 only if station 104 has been provisioned with a trigger for this service.* STP 114 forwards this information to service control point (SCP) 122. SCP 122 is capable of providing standard Advanced Intelligent Network (AIN) services based on the called telephone station, i.e. telephone station 104, to send caller identification information to new caller identification server 124. The SCP 122 examines the information received from STP 114 to determine if the called telephone station 104 is a subscriber to the caller identification storage and retrieval service according to the present invention. *If so, then SCP 122 forwards the caller identification to caller identification server 124.*

Caller identification server 124 receives the caller identification information from SCP 122, time stamps the information to log-in this information and stores the caller information in an area of server 124 associated with called telephone station. Alternatively, the time logging could be performed by the SCP 122, but the SCP 122 often has many intelligent network tasks to provide, so caller ID server 124 would be the preferred location to perform the time stamping for such a case. SCP 122 may also have a name associated with the caller identification as is provided in some advanced intelligent networks, and if available, this name is also stored in caller ID server 124 as part of the caller identification information. If the called number is the number of a subscriber to this service, this available caller identification information is stored in caller ID server 124 for each caller attempting to reach the called telephone station number, whether completed or not. Assuming, of course, that only a reasonable number of caller ID records must be stored per subscriber, otherwise storage component expense and retrieval processing time become prohibitive.

Since a caller at station 102 has called telephone station 104 and *called telephone station 104 is a station of the storage and retrieval service of the present invention, there is a record of this call in caller ID server 124.* Connected to caller ID server 124 is an internet protocol server 126. Internet protocol server 126 is preferably a hyper text transfer protocol type of server, also known as a web server, although file transfer protocol type servers or telnet protocol type servers are also contemplated for this service. *With the caller ID information for each subscriber stored in caller ID server 124, the next task is to provide retrieval in the easiest,*

most flexible and most advantageous ways. As shown in FIG. 1, a personal computer 130, or a similar type of workstation or video terminal station, is connected to the PSTN 110. This connection may be by POTS and FSK modem or by ISDN and ISDN modem in or attached to the personal computer 130, as examples. *A user at personal computer 130 can initiate a data call through PSTN 110 to internet protocol network 128.*

Internet protocol network 128 provides a gateway for data from PSTN 110 to internet services, such as internet protocol server 126. For the data call from personal computer 130, internet protocol network 128 converts the POTS-FSK modem signals to TCP/IP data signals, and then accesses internet protocol server 126 by internet protocol signaling.

At this point, internet protocol server 126 should require authentication of the accessing user by user identification and password protection. Assuming the user is authenticated, internet protocol server 126 accesses caller ID server 124 and reads the call record of calls for telephone station 104 using hypertext transfer protocol (http) or similar internet protocols. If a user is away from his or her telephone station but has a personal computer or similar device that can access the internet, the user can retrieve, from the service provided by the present invention, a displayed list of call time, caller telephone number (if not blocked at SCP 122) and caller name (if available from SCP 122). Further, this retrieved list can be prioritized, either at the servers 124 and 126 or at the personal computer 130. Prioritizing by one of the servers 124 or 126 means that a relatively simple browser or similar program may be used to access the prioritized information. Prioritizing at the personal computer 130 makes the tasks required of the servers 124, 126 less complex and less time consuming.

Referring now to FIG. 2, a representative display 200 of a retrieved caller information record is shown. This particular record is that of Mr. John Jones at number 630-YYY-XXXX. After he has accessed the internet protocol server 126, authenticated himself and had the server 126 retrieve his caller identification records from server 124, this type of information is presented. Mr. John Jones has prioritized his calls by caller, so his relative, Mrs. T. Jones, is listed first even though she called later than the caller first in time. *The next caller is probably a telemarketer because there was no caller number available, no caller name available.* This entry will typically be deleted from the record by the user. The next entry is Dr. Smith, who has not been placed in the priority list, so her call is put in chronological order at the end. Preferably, the personal computer 130 is provided with browser or similar software such that the fields of each record are interactive. A field may be included on each call record enabling the user to dial back a number in the retrieved list. Thus, if John Jones selects and activates the number in the record of

the call by "Mrs. T. Jones" a call is initiated. The call back may be accomplished in either of two ways, depending on the type of equipment and the number of telephone communication lines the user has. If the user has internet telephony and only one communication line, the call is accomplished using the internet protocol link and personal computer 130 using internet telephony hardware and software, versions of which are presently known and available. If the user has two communication lines, the personal computer 130 on one line can dial the selected number using a telephone dialer application on the other telephone line to dial the selected number, which in the above example is Mrs. T. Jones.

U.S. Patent No. 6,282,275, col. 1, line 66 thru col. 4, line 20; *see also*, Id., FIGS. 1, 2A, and 2B.

Referring to the first assertion by the Office that *Gurbani* teaches "user profile information comprising at least a caller directory number and at least one enhanced caller information that is pre-entered by the user," *Gurbani* teaches that when there is an incoming call, the SCP first determines if the called party is a subscriber to *internet access service*. If the called party is a subscriber, then caller identification data of the incoming call is sent to caller ID server 124 and the caller ID server 124 time stamps the call data and logs the incoming call's time stamp, caller's name (if available) and the caller's number (if available). Id. at column 3, lines 37-55 and column 4, lines 21-57. If the called party is NOT a subscriber, then the SCP sends the call back to the STP for processing, and, consequently, no caller identification data is sent to the caller ID server 124. Consequently, the caller identification data of *Gurbani* is provided by the SCP and does not include (1) at least a caller directory number and (2) *at least one enhanced caller information that is pre-entered by the user* (e.g., subscriber).

Referring now to the second assertion, *Gurbani* actually "teaches away" from the server providing enhanced caller information to the subscriber. "A reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. *See* M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. *See id.* at § 2141.02; *see also W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "It is improper to combine

references where the references teach away from their combination." M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. *See* M.P.E.P. at § 2143.01.

Gurbani teaches that the subscriber uses personal computer 130 or internet device 132 to access IP server 126. Then, the subscriber attempting to access the logged calls must enter authentication requirements (e.g., user name and password) to be granted access to the subscriber's records stored on IP server 126. If the subscriber cannot be authenticated, then access is denied. Id. at column 4, line 58 thru column 5, line 20. The Office should now realize that *Gurbani* "teaches away" from the proposed combination. The only way for *Gurbani* to "*provide the enhanced caller information from the server to the subscriber*," as independent claims 1, 18, 31, and 46 recite, is to completely ignore and eliminate the principle operating aspect of *Gurbani's* "caller ID internet access service" that requires the subscriber to use an internet device to access the IP server 126 and enter authentication requirements.

In regards to the third assertion that *Gurbani* suggests "it is necessary to match the calling party number to the caller directory number in the user profile information at the server in order to retrieve the correct caller information and provide the subscriber with accurate caller information," the Office is clearly wrong. *Gurbani* discusses and presents an example of an unmatched "caller directory number." As shown in FIGS. 2A and 2B, there is an entry without a caller directory number (i.e., "blocked at SCP) and without a caller name (i.e., not "available from SCP). *Gurbani* explains that this caller is "*probably a telemarketer because there was no caller number available, no caller name available. [Further], [t]his entry will typically be deleted from the record by the user.*" Id., column 3, lines 64-67. Consequently, Assignee must respectfully disagree that "it is necessary to match the calling party number to the caller directory number in the user profile information at the server in order to retrieve the correct caller information and provide the subscriber with accurate caller information." That is, *Gurbani* does not match the blocked caller directory number (blocked at SCP) with any caller information. FIGS. 2A

and 2B of *Gurbani* illustrate that the call log stores receipt of an incoming call with a time stamp, but without a caller number and without a caller name. Since the subscriber of *Gurbani* merely accesses a caller ID log of SCP information, the blocked caller number is not matched to any pre-entered caller information, such as, for example, an association of a blocked number with a telemarketer.

The additional independent claims recite similar features. Independent claims 12, 24, 37, and 43 all recites features for presenting presence information at a plurality of contact devices. Independent claim 12, for example, recites "the processor causing presentation of the recipient's presence information to the sender, *the presence information indicating the recipient's presence at a plurality of contact devices.*" Independent claim 24 recites "*presenting the recipient's presence information to the sender, the presence information indicating the recipient's presence at a plurality of contact devices.*" Independent claim 37 recites "*presenting the recipient's presence information to the sender, the presence information indicating the recipient's presence at a plurality of contact devices.*" Independent claim 43 recites "*a communications section displaying presence information of a recipient, the presence information indicating the recipient's presence at a plurality of addresses associated with a plurality of contact devices.*" The only way for the proposed combination of *Gurbani* and *Armstrong* to obviate these claimed features is to impermissibly alter, or even eliminate, *Gurbani's* principle of operation. Because such changes are not permissible, *Gurbani* cannot support a *prima facie* case.

In regards to the fourth assertion that *Gurbani* teaches "customer premise equipment includes cellular phones with data display (col. 2, lines 36-41)", and "therefore, it would have been obvious that there exists a mobile switching center in order to provision the subscriber's cellular phone," the Office is in error. As provided in the referenced passage, *Gurbani* discloses that "[a] *caller at telephone station 102 initiates a call to called party at telephone station 104 by using public switched telephone network (PSTN) 110. Telephone station 102* maybe connected to PSTN 110 via a POTS service, an ISDN service, a wireless service or even a telephone over internet call service, as long as PSTN 110 can receive the initiated call. PSTN 110 may include a local

telephone switch (not shown), such a 5ESS.RTM. by Lucent Technologies Inc. of Murray Hill, N.J. or comparable local telephone switch." *Gurbani* is completely silent as to a data display of telephone station 104 (i.e., the subscriber's telephone line). Further, while *Gurbani* indicates that the calling party's telephone 102 may be connected via a wireless service, *Gurbani* merely describes telephone station 104 as a "telephone station." No further language or suggestion is provided to indicate that telephone station 104 (i.e., "the subscriber's telephone line") is connected to PSTN 110 via a wireless service.

Consequently, *Gurbani* does not teach, disclose, or otherwise suggest the claimed subject matter of independent claims 1, 18, 31, and 46. Further, the *Gurbani* does not meet the burden of proof for a reasonable expectation of success, and in fact, *Gurbani* teaches away from the claimed subject matter. Claims 2-4, 11-17, 19-22, 27-30, 32-33, 36, 41-45, 47-50, and 55-62 depend from claims 1, 18, 31, and 46, and are considered allowable for at least the same reasons. Therefore, Assignee respectfully requests the Office to remove the rejection and allow these claims.

In regards to claims 7, 9, 23, 25, 37, 39, 51, and 53, *Tannenbaum* in combination with *Gurbani* does not cure the above discussed defects. Further, this combination fails to teach, disclose, or otherwise suggest that (1) the user profile information comprises at least a caller directory number and at least one enhanced caller information that is pre-entered by the user, (2) matching, at the server, the calling party number to the caller directory number, (3) selecting, at the server, based on the called party number, an enhanced profile information from the user profile information that has the caller directory number matching with the calling party number, and (4) providing the enhanced caller information from the server to the subscriber, said enhanced caller information being based at lest in part on the user profile information. Therefore, Assignee respectfully requests the Office to remove the rejection and allow these claims.

In regards to claims 5, 6, 8, 10, 24, 26, 34-35, 38, 40, 52, and 54, *Bushnell* in combination with *Gurbani* also does not cure the above discussed defects. Further, this combination fails to teach, disclose, or otherwise suggest that (1) the user profile

information comprises at least a caller directory number and at least one enhanced caller information that is pre-entered by the user, (2) matching, at the server, the calling party number to the caller directory number, (3) selecting, at the server, based on the called party number, an enhanced profile information from the user profile information that has the caller directory number matching with the calling party number, and (4) providing the enhanced caller information from the server to the subscriber, said enhanced caller information being based at lest in part on the user profile information. Claims 26 and 54 are canceled, and consequently, the rejection of these two claims is now moot. However, with respect to claims 5, 6, 8, 10, 24, 34-35, 38, 40, and 52, Assignee respectfully requests the Office to remove the rejection and allow these claims.

DUE PROCESS

As discussed above, the pending claims recite additional features that are not even remotely taught or suggested by *Gurbani* or the combination of *Gurbani*, *Tannenbaum*, and/or *Bushnell*. These rejections, then, are improper and must be withdrawn. Still further, maintaining these rejections is a violation of due process. If the Office wishes to factually support any of these rejections, then another office action is required. This other office action must follow the requirements of MPEP §§ 2131 and/or 2143. Further, this other office action cannot maintain the rejection — this other office action may ONLY properly present the reasons for the rejection. Further, once the Office properly follows MPEP §§ 2131 and/or 2143 and properly supports a rejection, the Assignee must be given another opportunity to rebut the rejection – *that is, the next office action can NOT be final.* Any other action is a violation of due process. Still further, any claim amendments presented in this Response are in reply to the request by the Office to change numbering informalities, and these claim numbering amendments do not constitute a basis for a new search.

CONCLUSION

All of the rejections have been overcome. Further, the reference cited by Office, alone or in combination, does not teach, disclose, and/or otherwise suggest the claimed subject matter. Still further, the Assignee respectfully asserts that the next office action may not be final because the Office has failed to meet the requirements set forth MPEP § 2143 – that is, *Gurbani* does not teach or otherwise remotely suggest each and every element such as, for example, user profile information that is pre-entered by the user, providing the enhanced caller information from the server to the subscriber, or that the system includes a trigger provisioned on a subscriber's telephone line at a mobile switching center. Accordingly, the Assignee respectfully request reconsideration and solicits a Notice of Allowance for all pending claims (claims 1-25, 27-53, and 55-62). Assignee further submits via a separate letter a Notice of Appeal from the January 9, 2006 Office Action.

AUTHORIZATION FOR PAYMENT OF FEES & REQUEST FOR AN EXTENSION OF TIME

Assignee respectfully requests an additional three month extension of time fee for the Response to the January 9, 2006 Office Action from April 9, 2006 to July 10, 2006 (since July 9, 2006 fell on a Sunday).

Description of Fee	Amount
Three Month Extension of Time Fee	$1020.00
Total	$1020.00

The Assignee, therefore, includes a Credit Card Payment Form PTO-2038 for $1020.00.

If there are any other fees due in connection with the filing of this response, please charge the fees to the credit card on file. If a fee is required for an extension of

time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to the credit card on file.

If the Office has any questions, the Office is invited to contact the undersigned at (757) 253-5729 (office), (757) 784-1978 (cellular), or bambi@wzpatents.com.

Respectfully submitted,

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